

The allegation that the title and abstract are not descriptive is believed to be moot in view of the submission of the new title and abstract.

Applicants submit that Claims 12 and 13 satisfy the requirements of 35 U.S.C. §112, second paragraph. The Office Action alleges that the steps of the instant claims do not define method of identification. In making this allegation, the Office Action does not properly construe the instant claims. The instantly claimed method is not concerned with identification of an unknown compound (see the top of page 4 of the August 27, 2002 Office Action). Rather, the claim is directed to how a compound within the database is identified. Within the virtual library, compounds are identified by the stored fragment and transformation data. The actions recited in claims 12 and 13 are the steps associated with assembling and storing the identification data which identify each compound. Thus, claims 12 and 13 are directed to a method of identifying each compound of a virtual library. As such, Applicants respectfully submit that the rejection should be withdrawn.

Applicants traverse the rejection of claims 12 and 13 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by STN Express User Guide (version 4.0, 1996) (hereinafter "the STN Express Reference"). The standard for anticipation under §102 is one of strict identity. An anticipation rejection requires a showing that each limitation of a claim be found in a single reference. *Atlas Powder Co. v. E.I. DuPont de Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984). Importantly, the Office Action's characterization of the Applicant's claims omits several steps (compare the amended claims 12 and 13 presented in the Preliminary Amendment filed with the application and pages 4-5 of the August 27, 2002 Office Action). For example, claims 12 and 13 contain the limitation "selecting each of said compounds for said virtual library and, for each, dissecting said compound into fragments". The Office Action does not allege that this limitation is contained in the STN Express Reference. Claims 12 and 13 also contain the limitation "assigning to each of said fragments at least one identifying characteristic" and the limitation "assigning at least one transformation characteristic to each of said synthesis rounds". Again, the Office Action contains no allegation that the STN Express Reference contains these limitations. As such, the rejection is insufficient as a matter of law. Furthermore, it is the position of the

Applicants that the STN Express Reference does not anticipate these limitations. Therefore, for at least these reasons, Applicants believe that the rejection should be withdrawn.

In view of the foregoing, Applicants respectfully submit that claims 12 and 13 are in condition for allowance. An early notice of the same is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE." Also attached hereto is the new abstract on a page captioned "NEW ABSTRACT".

Respectfully submitted,



John A. Harrelson, Jr.  
Registration No. 42,637

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WOODCOCK WASHBURN LLP  
One Liberty Place - 46th Floor  
Philadelphia, PA 19103  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Abstract:**

A new abstract is submitted herewith on separate paper.

**In the Title:**

Please replace the existing title with “A Method of Identifying *in silico* Each Compound of a Virtual Library”.